



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

MAIL STOP: AF

OF: WITSCHER ET AL.

CONFIRMATION No.: 4151

SERIAL No. 09/936,356

GROUP ART UNIT: 1626

FILED: SEPTEMBER 11, 2001

EXAMINER: R. L. ANDERSON

FOR: TRICYCLIC BENZOYLPYRAZOLE DERIVATIVES

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents and Trademarks, Alexandria, Va 22313-1450, on:

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Signature

Sobine Berg

Honorable Commissioner
for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY UNDER 37 C.F.R. §1.113(c)

Sir:

In reply to the Office action of February 16, 2005, it is respectfully requested that the following request for reconsideration be entered and considered by the Examiner:

REQUEST FOR RECONSIDERATION

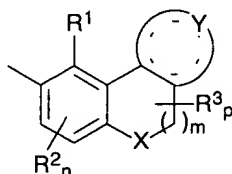
Claims 1, 5 to 16, 18 to 21 and 23 as presented by applicants with their reply dated June 30, 2004, are currently pending in this application. Claims 7, 9 to 11 and 13 stand allowed, Claims 18 to 21 stand withdrawn from consideration, and Claims 1, 5, 6, 8, 12, 14 to 16 and 23 stand rejected.

The Examiner reiterated her position that the subject matter of applicants' Claims 1, 5, 6, 8, 12, 14 to 16 and 23 was unpatentable under Section 103(a) in light of the teaching of *Tseng* (WO 97/19087) arguing that the referenced teaching encompassed applicants' invention.

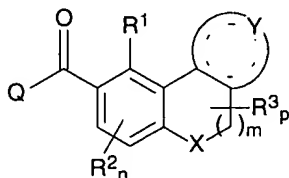
The Examiner's position is deemed to be in error because the compounds referenced in applicants' claims are clearly outside of the realm of the compounds which are addressed in the teaching of *Tseng*. Applicants' invention can therefore not reasonably be deemed to be encompassed by the teaching of *Tseng* as the Examiner would have it¹⁾. The teaching of *Tseng* relates to compounds of formula (I)



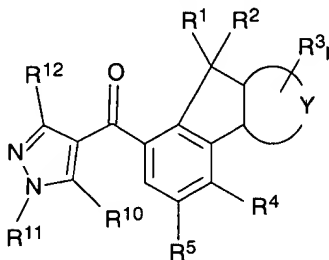
in which J is



The compounds of *Tseng* are, accordingly, represented by the following generic formula:



The teaching of *Tseng* provides that it is mandatory that the bicyclic system be condensed to the *meta* and *para* position of the phenyl ring, relative to the moiety Q-C(=O)-. In contrast thereto, applicants' claims relate to compounds of formula (I)

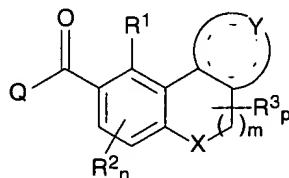


which requires that a particular bicyclic moiety be condensed to the the *ortho* and *meta* position of the phenyl ring, relative to the moiety (pyrazol)-C(=O)-. The formulae representing *Tseng*'s compounds and applicants' compounds are mutually exclusive.

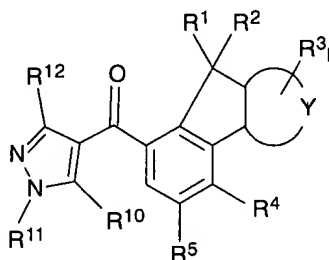
Moreover, even if the teaching of *Tseng* were generic to applicants' invention, which is not the case, it is well settled that a prior art genus alone is not enough to establish a *prima facie* case of obviousness under Section 103(a) particularly when the prior art

1) Cf. applicants' reply dated June 30, 2004.

disclosure indicates preferences leading away from the claimed compounds²⁾. Although the generic formula of **Tseng** admits of tricyclic moieties in which the central ring has five members³⁾, the structures which are preferred by **Tseng** comprise a six or seven membered central ring⁴⁾. Correspondingly, the teaching of **Tseng** does not provide for any exemplary compounds which comprise a five membered cyclus as the central ring of the tricyclic moiety. It is also well settled that it is necessary for obviousness under Section 103(a) that the reference provide some teaching which conveys that it is desirable to do what the applicant has done⁵⁾. The teaching of **Tseng** clearly fails to suggest the desirability of a five membered cyclus as the central ring of the tricyclic moiety. The teaching of **Tseng** equally fails to suggest the desirability of compounds which fail to meet the structural requirements of **Tseng**'s formula



A person of ordinary skill in the pertinent art would therefore not have been motivated by the teaching of **Tseng** to modify the prior art compounds as is necessary to arrive at applicants' compounds of formula (I)



In light of the foregoing and in light of the arguments already presented by applicants in the earlier part of the proceedings it is therefore respectfully urged that the teaching of **Tseng** cannot reasonably be deemed to render applicants' invention *prima facie* obvious

2) Cf. *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (CAFC 1994).

3) I.e. **Tseng**'s compounds in which m denotes 0 rather than 1 or 2, cf. page 4, indicated line 5, of **WO 97/19087**.

4) Cf. page 12, indicated lines 17 and 31, page 13, indicated lines 3 and 15, of **WO 97/19087**.

5) Cf. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (CAFC 1991). See also *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (CAFC 1994); *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (CAFC 1992).

within the meaning of Section 103(a). Favorable reconsideration of the Examiner's position and withdrawal of the respective rejection is solicited.

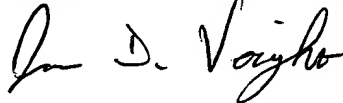
REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a one month extension of time be granted in this case. The respective \$120.00 fee is paid by credit card (Form PTO-2038 enclosed).

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

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